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EXAMINER

NGUYEN, QUANG N

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 03/26/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/513,236

Applicant(s)

PARTOVI ET AL.

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_



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***Detail Action***

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/04/2003 has been entered.

2. Claims 1-13 and 16-17 are presented for examination. Claims 1 and 12 have been amended.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily



published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 4-5, 7 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Wise et al. (US 5,884,262), herein after referred as Wise.

5. As to claim 1, Wise teaches a method of using a telephone identifying information to present information over a telephone interface using a first computer comprising:

using the telephone identifying information to access a user profile (through a caller ID or other AIN identification features) with the first computer, the user profile including a corresponding telephone identifying information matching the telephone identifying information (Wise, C3: L9-18 and C9: L10-12);

using the first computer to update the user profile to include an implicitly made selection by a user over the telephone interface, wherein the implicitly made selection comprises a record of behaviors and actions performed over the telephone interface, e.g., a certain user regularly checks the closing price of a certain stock and the traffic report for the area near the user's house over the telephone, (i.e., implicitly made selection comprising a record of behaviors and actions) could be added/updated to the user profile so later that user may have a profile that provides suggestions direct to his interests instead of traversing several system menus and submenus to access the desired information (Wise, C9: L2-10); and



presenting a suggestion (e.g., "Press 1 for the Bell Atlantic stock closing price and the traffic report for the Silver Spring area. Press 2 for other menu options.") to the user over the telephone interface using the computer, the suggestion based on the user profile, the suggestion comprising at least one of a topic (stock closing price and traffic report), a sub-topic, a content, and an item for sale that may be selected for purchase by the user (Wise, C9: L5-10).

6. As to claim 2, Wise teaches the method of claim 1, further comprising: receiving a response to the suggestion over the telephone interface (i.e., response to selection of checking stock closing price and traffic report); and updating the user profile according to an explicitly made selection comprising the received response (Wise, C9: L2-10).

7. As to claim 4, Wise teaches the method of claim 1, further comprising requesting a voice login over the telephone interface after using the telephone identifying information to access the user profile (Wise, C3: L9-18 and C9: L27-34).

8. As to claim 5, Wise teaches the method of claim 1, wherein the telephone identifying information comprises a telephone number (a caller ID used to identify a telephone number, Wise, C3: L9-18).

9. Claim 7 is a corresponding computer system of claims 1-2; therefore, it is rejected under the same rationale.



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10. As to claim 9, Wise teaches the computer system of claim 7, wherein the telephone identifying information includes automatic number identifications (ANIs) such as caller number identifications (CIDs) used by the first program code to perform matching of calls to personalization profiles (Wise, C3: L9-18 and C9: L13-26).

11. As to claim 10, Wise teaches the computer system of claim 7, wherein the server includes a web server for presenting customized interfaces to users to access and to modify the personalization profiles (Wise, web server IP 350 of Fig. 3, C8: L44-54).

12. As to claim 11, Wise teaches the computer system of claim 7, wherein the telephone interface subsystem includes a call manager supporting multiple simultaneous telephone calls over the telephone interface (Wise, call manager 210 of Fig. 2, C6: L14-30 and C8: L37-43).

13. Claim 12 is a corresponding apparatus claims of claims 1-2; therefore, they are rejected under the same rationale.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and



the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3, 8, 13 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wise, in view of Kamel et al. (US 5,937,037).

16. As to claim 3, Wise teaches the method of claim 1, presenting various information such as weather, traffic, investment/finance or/and sports but does not explicitly teach to present at least one advertisement over the telephone interface, the at least one advertisement qualified based on the user.

In the related art, Kamel teaches a telecommunication system, which flexibly and efficiently delivers targeted promotional messages (advertisements) to end-user subscribers, preferably based on profiles, preferences and/or interests via switched telephone networks and telephone devices (Kamel, C11: L23-35, L64-67 and C12: L1-17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Wise and Kamel to present at least one advertisement over the telephone interface, the at least one advertisement qualified based on the user profile because it would allow the system to efficiently deliver targeted promotional messages (advertisements) to the end-user subscribers based on profiles, preferences and/or interests and allow the advertisers to use/combine standard (i.e., predefined) geographic parameters with subscriber profile parameters to target/reach the potential customers.



17. As to claim 8, Wise-Kamel teaches the system of claim 7, wherein the telephone identifying information includes automatic number identifications (ANIs) that are used to determine geographic locations identifying the approximate geographic locations of the source of the corresponding telephone calls, and wherein the personalized content includes at least one advertisement determined from a corresponding approximate geographic location (Kamel, C9: L8-16, C10: L66-67 and C11: L1-9).

18. Claim 13 is a corresponding claim of claim 3; therefore, it is rejected under the same rationale.

19. As to claim 16, Wise-Kamel teaches the apparatus of claim 13, further comprising means for modification of the personalization profile by a user via an Internet link (e.g., if a user's equipment was a personal computer rather than a telephone, the presentation manager would modify the presentation format for audio/visual interface rather than an audio, i.e., telephone interface so the user can access the system to modify the profile via the Internet) (Wise, C8: L44-54).

20. As to claim 17, Wise-Kamel teaches the apparatus of claim 16, further comprising means for modification of the personalization profile by reserve lookup to obtain demographic information (i.e., using the caller ID or location ID from the user's cellular phone to obtain the telephone's geographic location) (Wise, C9: L13-26).



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21. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smyk (US 6,161,128), in view of Wise.

22. As to claim 6, Smyk teaches a method of modifying user profile by using a telephone identifying information comprising:

requesting addition of a topic to the first computer (web server 204 of Fig. 2) from a first web site hosted by a second computer (client/AIN subscriber 201 of Fig. 2, Smyk, C4: L50-63, C5: L48-62, C9: L20-67 and C10: L1-32);

sending a message from the second computer to the first computer (by clicking the submit button), the message comprising the telephone identifying information and the topic (Smyk, Figs. 4A-B, C9: L20-67 and C10: L1-32);

adding the topic to a user profile having an associated telephone identifying information matching the telephone identifying information on the first computer responsive to the message (Smyk, Figs. 4B-C, C9: L41-67 and C10: L1-32);

However, Smyk does not explicitly teach the method comprising: using the first computer to present content relating to the topic included in the user profile over the telephone interface responsive to receiving the telephone identifying information over the telephone interface.

In the related art, Wise teaches a method allowing a user to access information (user profile) on a computer network via a simple telephone (Wise, C9: L2-10 and C5: L55-65).



Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Smyk and Wise to include the method of using the first computer to present content relating to the topic included in the user profile over the telephone interface responsive to receiving the telephone identifying information over the telephone interface because it would allow user to access information contained on a computer network, including the Internet, without a computer terminal (Wise, C3: L26-34).

### ***Response to Arguments***

23. In the remarks, applicant argued in substance that

(A) Prior Art (Wise) does not teach or suggest "updating the user profile to include an implicitly made selection by a user over the telephone interface".

As to point (A), Wise teaches a certain user regularly checks the closing price of a certain stock and the traffic report for the area near the user's house (i.e., an implicitly made selection of a certain stock closing price and region/location traffic report) could be added/updated to the user profile which later is used to provide suggestions direct to his interests instead of traversing several system menus and submenus to access the desired information over the telephone interface.

(B) Prior Art (Wise) does not teach or suggest "presenting a suggestion to the user".



As to point (B), Applicant defines "A suggestion is defined as the act of proposing a thing as suitable or possible for some purpose. A suggestion may be a piece of advice" as in Page 8, Lines 11-12 of the Request for Continued Examination. Wise does teach the presenting a suggestion to the user as proposing/presenting choices/options to the user "Press 1 for the Bell Atlantic stock closing price and the traffic report for the Silver Spring area. Press 2 for other menu options." based on the user profile (e.g., based on regularly checking the closing price of a certain stock and the traffic report for the area near the user's house in Silver Spring, MD, before leaving the office) over the telephone interface (Wise, C9: L2-10).

24. Applicant's request for reconsideration as well as arguments filed on 03/04/2003 have been fully considered but they are moot in view of the new ground(s) of rejection.

25. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.



26. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Le H. Luu, can be reached at (703) 305-9650. The fax phone numbers for the organization is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen

A handwritten signature in black ink, appearing to read 'Le Hien Luu', is written over a horizontal line.

LE HIEN LUU  
PRIMARY EXAMINER